STATEMENT OF SUBSTANCE / NON-FINAL RCE FIRST OFFICE ACTION

The 15 January 2008 telephonic examiner interview (by and between Examiner Thomas A. Morrison and the undersigned) is respectfully noted; in such interview, it was agreed by the Examiner that if the present RCE was filed with claim amendments corresponding to those submitted via applicant's 30 November 2007 amendment, then the Examiner would not make a first action final. It is respectfully submitted that the claim amendments submitted herewith correspond to those submitted on 30 November 2007. The Examiner is thanked for the interview.

REMARKS

By the present amendment, independent claims 21 and 25 have been amended to clarify the features of the present invention. Claims 22-24 and 26 remain as previously presented, dependent claim 27 has been amended, and new claims 28-31 have been added to further clarify features of the present invention. No new matter has been added.

At the outset, applicants submit that the present invention is directed to a novel and non-obvious paper money receiving and paying apparatus shown for example in Figures 3, 20 and 27a-27d and described starting at page 26, line 8 to page 31, line 10. The apparatus comprises a stacking device 8 for stacking paper moneys therein, a paper money size detector 3, a travel regulating member 812 to regulate travels of a collected bundle of only paper moneys of a same size, and a controller 9 to control the travel regulating member to be rotated to move the received and held collected bundle of paper moneys of the same size to be stacked into the stacking device. As recited in new claims 29 and 31 and described on page 29, lines 2-18, the controller also controls a height of the travel regulating member

based on a size of the collected bundle of paper moneys being introduced into the stacking device. The travel regulating member further comprises a stopper part 812a and a paper money supporting part 812b, as recited in new claims 28 and 30. By this overall configuration, as described on page 28, lines 14-19, paper moneys are successively conveyed to the loading and recovering bin (stacking device) 8 for each of the return bins 7 for respectively storing different denominations of paper moneys, in other words, paper moneys having one and the same size are conveyed in a bundle to the associated loading and recovering bin 8.

In response to the rejection of claims 21-23 under 35 USC 102(e) and 102(a) as being anticipated by Nomiyama et al (US 2003/0127509); the rejection of claims 21, 23, 25 and 26 under 35 USC 102(b) as being anticipated by Intl. App. Pub. No. WO00/24662; and the rejection of claim 24 under 35 USC 103(a) as being unpatentable over Nomiyama et al ('509) in view of Beskitt et al (USPN 6331000), such rejections are traversed insofar as they are applicable to the claims, as amended, and newly added claims, and reconsideration and withdrawal of the rejections are respectfully requested.

Rejections based on 35 USC 102

As to the requirements to support a rejection under 35 USC 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To

establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Irrespective of the Examiner's comments concerning the applicability of Nomiyama et al. ('509) or Intl. App. Pub. No. ('662) to the previous claimed invention, applicants submit that neither Nomiyama ('509) or Intl. App. Pub. No. ('662) discloses in the sense of 35 USC 102 or teach in the sense of 35 USC 103, the recited features of the pending claims of this application. First, Nomiyama ('509) does not anticipate, disclose, or teach the recited features of the present invention. Nomiyama ('509) does not disclose a travel regulating member to regulate travels of a collected bundle of only paper moneys of a same size to be stacked in the stacking device. Rather, as shown in Figs. 20A- 20D, Nomiyama ('509) teaches a stacking assist member 812 that loads one bill at a time into the storage box 8. As shown in the figures, as a bill 1000 is loaded into the storage bin, each of the stacking assist members 812 stacks only one bill then rotates to move the bill into the storage box 8 while the next member 812 is rotated to receive the next single bill. The stacking assist members 812 of Nomiyama ('509) are not configured to regulate a collected bundle of only paper moneys of a same size. As can be seen in Figures 20A – 20D, the stacking assist members 812 only consist of a small hook-like region to receive a single bill. On the contrary, the travel regulating member of the present invention includes a stopper part 812a and a paper money supporting part 812b, described on page 26, lines 14-18, which are configured to receiving and hold thereon the

collected bundle of only the paper moneys of the same size to be stacked into the stacking device.

Further, amended independent claims 21 and 25 recite regulating the travel of a collected bundle of "paper moneys," plural. In the outstanding office action, the Examiner theorized that Nomiyama ('509) would function in the same manner as the present invention if a number of $5 bills were fed into the prior art device consecutively. However, as pointed out to the Examiner at the Interview on November 28, 2007, this method would not serve to anticipate the features of the present invention. As discussed above, Nomiyama ('509) is designed to only stack one bill at a time and move that one bill at a time into the storage bin 8. If one was to feed multiple $5 bills or multiple bills of only one size into the prior art device, the bills would still only be stacked and moved one at a time. On the contrary, per the features of the present claims, the paper money size detector 3 of the present invention detects bills of the same size being loaded to stack and hold a collected bundle of the plurality of sheets of paper moneys. The degree of occupation of the paper moneys is then detected by a stacked space volume detecting means 890, as recited in currently amended claim 27, before the controller controls the travel regulating member to be rotated to move the received and held collected bundle of paper moneys of the same size to be stacked into the stacking device. Further, as shown in Fig. 17 of Nomiyama ('509), the stacking assist member 812 of Nomiyama ('509) does not move only paper moneys of the same size into the charging/recovery storage box 8, but rather different sizes of paper moneys are stacked adjacent each other.

Second, the prior art of Intl. App. Pub. No. ('662) does not anticipate the claims of the present invention because Intl. App. Pub. No. ('662) discloses a Sheet

Stacking Apparatus that does not have a paper money size detector for detecting sizes of paper moneys, but must be manually adjusted by an operator as described at page 8, lines 7 – 9, wherein the sorter controller 11 looks up the sizes of the denominations initially inputted by the operator via the console 8, as described at page 8, lines 14-16. Further, Pub No. ('662) does not have a travel regulating member, does not have a controller for controlling the travel regulating member, nor does the prior art disclose receiving and holding a collected bundle of only paper moneys of the same size before moving the received moneys into a stacking device. For at least these reasons, the features recited in the claims of the instant application clearly distinguish over the disclosure of Intl. App. Pub. No. ('662).

In response to the Examiner's suggestion that certain limitations of claims 21 and 25 are "conditional," applicants, after a successful interview with the Examiner, have amended the original language of the claim, with further suggestions by the Examiner, to obviate the issues regarding what was alleged to be "conditional" phrasing in the claims.

Rejections based on 35 USC 103

As to the rejection of claim 24 as being unpatentable over Nomiyama ('509) and further in view of Beskitt ('000); and the rejection of claim 24 under 35 USC 103(a) as being unpatentable over Intl. App. Pub. No. ('662) and further in view of Fortuna et al ('256); these rejections are also traversed. Since Nomiyama ('509) does not disclose the features of parent independent claim 21, as discussed above, and claim 24 recites additional features in combination with the features of claim 21, applicants submit that claim 24 further patentably distinguishes over the cited art and should be considered allowable thereover.

In view of the above amendments and remarks, applicants submit that all claims present in this application should now be in condition for allowance and issuance of an action of favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case No. 500.43493X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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